

REMARKS

The Examiner has made a restriction requirement between the following two groups of claims.

Group I: Claims 1-18 drawn to compositions containing amino acids or protein components/hydrosylates and sucralose, classified in class 424, subclass 439+.

Group II: Claims 19-36, drawn to methods for masking unpleasant tastes, classified in class 426, subclass 72+.

The Examiner has asserted that the inventions are distinct from each other because they are related as product and process of use. According to the relevant standards for inventive distinctness (MPEP 806.05h) inventions are distinct if the process for using the product as claimed can be practiced with another materially different product or, alternatively, the product as claimed can be used in a materially different process of using that product. In the present case, the Examiner has stated that the process or method as claimed can be practiced with materially different compositions such as cyclodextrins and liposomes. However, it is submitted that the Examiner has not brought forward any substantial evidence from which this inference may properly be drawn.

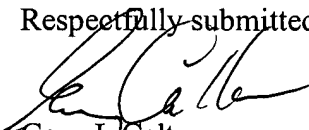
The process of patent examination is to be determined by written evidence of record (35 USC 132) in order to permit adequate review of the record upon any subsequent appeal or further proceedings. See, for example, *Gechter v. Davison* 43 USPQ 2d 1030, 1033 (Fed. Cir. 1997). The issue is not whether the decision of the Examiner or of the Office is correct merely because factual findings might have been made and considerations disclosed which would justify the decision but rather, there must be a responsible finding of fact based on the record indicating the considerations underlying the action under review. See *SEC v. Chenery*, 318 US 80, 89 to 93 (1943). In the present case, it is the presently claimed compositions and the claimed process which are relevant to this consideration (*cf.* MPEP 806.05h) rather than any general class of materials to which the present products might belong and the Examiner has

provided absolutely no factual underpinnings for the unsupported conclusions that the *claimed* process can be practiced – or might be practiced or is even capable of being used with any perceptible results – using the specified compositions.. Given therefore that the Examiner’s decision is unsupported by any findings of fact, it is inappropriate and should be withdrawn.

The Examiner also asserts that the inventions “have acquired a separate status in the art as shown by their different classification” as a basis for the requirement for restriction. This again is a totally unsupported factual finding. If the art in question is the art of amino acids or protein containing compositions or the process of masking amino acids or protein containing compositions, the Patent Office classification has not been shown to be a reflection of any recognized separate status, at least by those who are actively engaged in this art. It may be a reflection of a separate status as recognized by officials of the Patent Office and this may properly reflect a separate status recognized in the art of examining patent applications but it is submitted that this is not the art to which the Examiner has referred nor may it be properly considered as the art upon which a decision of patentable distinction may be made. If this were so, the Patent Office would, by any change in its classification, be able to create supposedly recognized separate classes of status in any given industrial or useful art and then to rely merely upon the classification as the basis for the purported separate status. Unless supported by evidence of actual recognized separate status in the art, as practiced outside the walls of the Office, such action could only be considered as arbitrary and capricious and an abuse of administrative discretion. In itself therefore the statement of the Examiner regarding separate status in the art is wholly lacking in any factually supported jurisdiction for the restriction requirement that non-elective claims 19-36, drawn to a method for masking unpleasant tastes, are not cancelled at the present time.

For reasons as stated hereinabove, it is believed that the Requirement for Restriction is improper and should be withdrawn.

Respectfully submitted



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